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LMC1/0814

EXAMINER

PATEL, J

ART UNIT

PAPER NUMBER

2765

DATE MAILED:

08/14/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/311,558

Applicant(s)

ALAIA et al.

Examiner

Jagdish Patel

Group Art Unit

2765



☒ Responsive to communication(s) filed on Jun 6, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 71-76 and 89-93 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 71-76 and 89-93 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 5

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## **DETAILED ACTION**

### ***Response to Amendment***

1. This communication is in response to the applicant's amendment filed 6/6/00.

Claims 71 and 74 have been amended and new claims 89-93 have been added.

2. In view of the amended claims, rejection of claims 71-76 under 35 USC 112, second paragraph has been withdrawn.

3. New claims 89-93 have been rejected. Claims 71-76 rejection is maintained.

### ***Response to Arguments***

4. Applicant's arguments filed have been fully considered but they are not persuasive.

Applicant has attempted to challenge the examiner's taking of Official Notice on page 4 Line 7; however, applicant has not provided adequate information or argument so that *on its face* it creates a reasonable doubt regarding the circumstances justifying the Official Notice. Therefore, the presentation of a reference to substantiate the Official Notice is not necessary. The examiner's taking of Official Notice is maintained. See also *Inre Boon*, 439 F.2d 724, 169 USPQ 231 (CCPA 1971). (Refer to MPEP section 2144.03).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching,

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suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation to combine the references is found in the knowledge generally available to one of ordinary skill in the art. The motivation to use different bid ceiling or floor as indicated in prior office action, that the use of bid ceiling would limit seller's requirements of creditworthiness or capacity of meet production and quality of goods and individual bid floor would reduce a risk that a bid received from a potential seller is economically viable consistent with the seller's credit worthiness.. (page 4, L 12-16, items (A) and (B) on page 4 of prior office action) is based on the knowledge generally available to one of ordinary skill in the art. For this reason the examiner asserts that one of ordinary skill in the art would be motivated to apply bidder specific ceiling or bidder specific floor for each of a plurality of bidders as recited in claims 71 and 74. This discussion also applies to new claims 89-93 because these claims recite similar limitations pertaining to bidder specific bid limits.

Therefore, rejections of claims 71-76 under 35 USC 103 are maintained.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

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such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 71-76, 89 and 91 are rejected under 35 U.S.C. 103(a) as being unpatentable over published article "SOLD! ... TO THE LOWEST BIDDER, Computer Finance, v6, n2, July 1995.

The reference article teaches a method of conducting an online auction between a buyer and a plurality of potential sellers (suppliers) in a format known as RATS ( Reverse Auction Tendering System) substantially as recited in the subject claims. This articles teaches the essential steps of conducting an online auction including setting an individual bid ceiling (and bid floor) for at least one of said plurality of potential bidders (sellers) (p. 2 L 27-35). The steps of receiving bids, determining whether a received bid for a potential seller is greater than a corresponding individual bid ceiling (or bid floor) set for a potential seller ( (p. 2 L 27-35). The articles clearly teaches the benefits of bid ceiling (ceiling price) and bid floor (or target lowest price) on p. 2 L 27-46).

The aforementioned article do not clearly teach that the bid ceiling and the bid floor are applied to a plurality of potential sellers.

Official Notice is taken that bidder specific ceiling and floor are old and well known concepts in art of commercial auctions and project procurement.

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to include individual bid ceilings and bid floors for each of a plurality of bidders in the method taught by the Computer Finance article to obtain the claimed invention because:

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(A) individual bid ceiling would limit those sellers who can meet the requirements of the buyer such as creditworthiness and capacity to meet production and quality of goods.

(B) individual bid floor would reduce a risk that a bid received from a potential seller is economically viable consistent with the sellers creditworthiness and capacity to meet production and quality of goods.

All limitations of claims 89 and 91 are analyzed as in claims 71-74 above.

*Claim Rejections - 35 USC § 102*

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

8. Claims 89, 90, 92 and 93 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by Brett et al. (US Pat. 6,023,685).

Regarding claim 89, Brett discloses a method to limit bids in an electronic auction, comprising:

setting a bid limit for each of a plurality of potential bidders, with one bid limit being different from another bid limit (col. 7, L 5-8, bid limit is set in accordance with individual bidder's credit information, see Fig. 7 Field "SLIMIT");

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receiving a bid from one of said plurality of bidders (bids are received at a central computer 12, Fig. 1, see col. 4 L 17-20, col. 7 L 45-51);

comparing said received bid to a bid limit set for said potential bidder; and sending a bid message to said bidder... (col. 8 L 1-10).

Regarding claim 90, the bid limit recited by Brett is a bid ceiling ("established maximum" identified as "SLIMIT", col. 8 L 1-6);

Regarding claim 92, said bid message is invalid bid message (Fig. 4 items 46-47).

Regarding claim 93, said bid message is valid bid message (Fig. 4 items 46-48).

### *Conclusion*

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jagdish Patel whose telephone number is (703) 308-7837. The examiner can normally be reached Monday-Thursday from 8:00 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tod Swann, can be reached at (703) 308-7791.

The fax number for Formal or Official faxes to Technology Center 2700 is (703) 308-9051 or 9052. Draft or Informal faxes for this Art Unit can be submitted to (703) 308-5397.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

JNP 8/9/00

  
ERIC W. STAMBER  
PRIMARY EXAMINER